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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,363	12/22/2000	Tomoo Yamaguchi	Q62262	8173

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EXAMINER

AHMED, SHEEBA

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 06/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/742,363

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

1. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogawa (JP 11-80690).

Ogawa discloses a pressure sensitive adhesive (PSA) composition and an adhesive sheet (***thus meeting the limitation that the PSA is applied to a substrate as recited in claim 9***) comprising the pressure sensitive adhesive composition wherein the PSA comprises 100 parts by weight of an elastomer such as natural rubber (***corresponding to the rubbery polymer of the claimed invention and meeting the limitations of claims 2 and 11***), 50-150 parts by weight of a tackifier (***thus meeting the limitations of claims 5 and 14***) and 0.1 to 10 parts by weight of a polyisocyanate compound such as 4,4'-diphenylmethane diisocyanate (***thus meeting the limitations of claims 6, 7, 15, and 16***). With regards to the limitation that the natural rubber has a Mooney viscosity of 20 to 100, i.e., ***claims 3 and 12***, the Examiner takes the position that the rubber disclosed by Ogawa inherently meets such a limitation given that the

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chemical composition and structure of the rubber disclosed by Ogawa and that of the claimed invention are identical. Furthermore, the determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985) and MPEP 2113. In the case, the PSA is the same despite the process limitation of conducting the treatment at a temperature of 80 to 160°C as recited in **claims 8 and 17**. All limitations of the claimed invention are either inherent or disclosed in the above reference.

2. Claims 1-17 are rejected under 35 U.S.C. 102() as being anticipated by Sashihara et al. (US 6,251,517 B1).

Sashihara et al. disclose a pressure sensitive adhesive (PSA) composition comprising 100 parts by weight of natural rubber (**thus meeting the limitations of claims 2 and 11**), 50 parts by weight of terpene-phenolic resin (**corresponding to the tackifier of the claimed invention and meeting the limitations of claims 4, 5, 13, and 14**) and 40 parts by weight of an isocyanate hardening agent having three functional groups (**thus meeting the limitations of claims 6, 7, 15 and 16**) (See Examples 1 and 2). The PSA composition may be prepared as a coating liquid and applied to a support sheet and dried to produce a PSA sheet (Column 7, lines 36-45). The thickness of the coated PSA layer may be 30 microns (**thus meeting the limitation of claim 10**) after drying (See Example 1). ). With regards to the limitation

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that the natural rubber has a Mooney viscosity of 20 to 100, i.e., **claims 3 and 12**, the Examiner takes the position that the rubber disclosed by Sashihara et al. inherently meets such a limitation given that the chemical composition and structure of the rubber disclosed by Sashihara et al. and that of the claimed invention are identical.

Furthermore, the determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985) and MPEP 2113. In the case, the PSA is the same despite the process limitation of conducting the treatment at a temperature of 80 to 160°C as recited in **claims 8 and 17**. All limitations of the claimed invention are either inherent or disclosed in the above reference.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Creegan et al. (US 3,914,484).

Creegan et al. disclose a pressure sensitive adhesive (PSA) composition and labels employing such a composition (Column 1, lines 5-10). The PSA comprises natural rubber (**thus meeting the limitations of claims 2 and 11**) and a tacky resin

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and a polyisocyanate, preferably a diisocyanate (*thus meeting the limitations of claims 6 and 15*) (Column 2, lines 10-20). The tacky resin may be a rosin ester or a terpene resin (Column 4, lines 11-50). The amount of tacky resin may range from 30 to 70% by weight and the ratio by weight of the tacky resin to elastomeric base may range from 1:2 to 2:1 (*thus meeting the limitations of claims 5 and 14*) (Column 4, lines 59-67). Example 1 shows that the composition may comprise 8 parts by weight of diisocyanate relative to 100 parts of the rubber (i.e., 6 lbs. of diisocyanate relative to 70 lbs. of rubber) (*thus meeting the limitations of claims 7 and 16*) and that the PSA composition is coated on a paper web (*thus meeting the limitations of claim 9*).

With regards to the limitation that the natural rubber has a Mooney viscosity of 20 to 100, i.e., *claims 3 and 12*, the Examiner takes the position that the rubber disclosed by Creegan et al. inherently meets such a limitation given that the chemical composition and structure of the rubber disclosed by Creegan et al. and that of the claimed invention are identical. Furthermore, the determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985) and MPEP 2113. In the case, the PSA is the same despite the process limitation of conducting the treatment at a temperature of 80 to 160°C as recited in *claims 8 and 17*. All limitations of the claimed invention are either inherent or disclosed in the above reference.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa (JP 11-80690) in view of Applicants own admission.

Ogawa, as discussed above, do not specifically teach that the PSA composition is applied to a substrate via calendaring or extrusion coating. However, the Applicants, on Page 1 of the Specification, specifically state that it is known to apply a PSA composition on a substrate via a calender roll coater, extruder or the like. Hence, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to apply the PSA composition disclosed by Ogawa to a substrate via calendaring or extrusion coating given that the Applicants admit that it is known in the art to apply a PSA composition to a substrate via calendaring or extrusion coating.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sashihara et al. (US 6,251,517 B1) ) in view of Applicants own admission.

Sashihara et al., as discussed above, do not specifically teach that the PSA composition is applied to a substrate via calendaring or extrusion coating. However, the Applicants, on Page 1 of the Specification, specifically state that it is known to apply a PSA composition on a substrate via a calender roll coater, extruder or the like. Hence,

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the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to apply the PSA composition disclosed by Ogawa to a substrate via calendaring or extrusion coating given that the Applicants admit that it is known in the art to apply a PSA composition to a substrate via calendaring or extrusion coating.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Creegan et al. (US 3,9147,484) in view of Applicants own admission.

Creegan et al., as discussed above, do not specifically teach that the PSA composition is applied to a substrate via calendaring or extrusion coating. However, the Applicants, on Page 1 of the Specification, specifically state that it is known to apply a PSA composition on a substrate via a calender roll coater, extruder or the like. Hence, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to apply the PSA composition disclosed by Ogawa to a substrate via calendaring or extrusion coating given that the Applicants admit that it is known in the art to apply a PSA composition to a substrate via calendaring or extrusion coating.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703)305-0594. The examiner can normally be reached on Mon-Fri 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703)308-2367. The fax phone



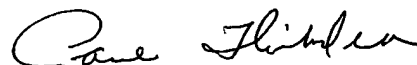
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numbers for the organization where this application or proceeding is assigned are (703)305-5408 for regular communications and (703)305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5665.

SA

Sheeba Ahmed  
June 19, 2002



Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700